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June 13, 2006

In re Application of:
Karsten ANDERSEN, ET AL.
Application No. 10/613,396
Filed: July 3, 2003

: DECISION ON PETITION TO
: REVIEW RESTRICTION
: REQUIREMENT UNDER
: 37 CFR 1.144

This is in response to the petition filed March 29, 2006 under 37 CFR 1.144 requesting the Director to review the final requirement for restriction. The petition requests the Director to withdraw the requirement for restriction and substitute a new restriction requirement.

A review of the record indicates that a requirement for restriction was mailed on September 16, 2004. The restriction requirement identified four species:

Species A – Figures 3-17 and claims 1-7 and 9-10;
Species B – Figures 19-25 and claim 8;
Species C – Figures 26-32; and,
Species D – Figures 33-45

Additionally, claim 11 was identified as being generic.

Applicants responded on February 22, 2005 with an election of Species A, claims 1-7 and 9-10. Election was made with traverse. Applicants argued the Examiner failed to identify a Species in connection with claim 11 and that claim 11 should be considered as part of Species A. Applicants further argued, "Law requires that a restriction requirement be based on claims, not on figures."

In the first Office action on the merits dated May 4, 2005, Examiner noted Applicants' election with traverse and withdrew claim 8 as being drawn to a nonelected species. Examiner pointed out the restriction of Species A and B was based on claims and that claim 11 was found to be generic. Therefore, the Examiner deemed the requirement proper and was made Final.

In Applicants' response, dated July 29, 2005, it was further argued the Examiner did not refer to Species C and D. Applicants requested the Examiner to withdraw the restriction to Species C and D as well as identify Species A and B to claims, not to figures. Applicants also argued that since the Examiner did not mention Species C or D in the Office action dated May 4, 2005, it could be assumed the Examiner withdrew the restriction requirement concerning Species C or D. The response also noted that since Examiner did not mention the original characterization of Species A being directed to Figures 3-17 and Species B being directed to Figures 19-25, it could be assumed

the Examiner withdrew the restriction requirement concerning Species A and B to the extent the requirements refer to figures. Applicants also added new claims 12-31.

In the Final Office action dated October 4, 2005, Examiner reiterated there was no obligation or a requirement to set forth the restriction with regard to claims as per MPEP 809.02(a). Examiner also indicated that Applicants incorrectly assumed any restriction requirement was withdrawn or modified.

At the outset, Applicants are reminded that MPEP 809.02(a) clearly indicates the actions that should be followed by the Examiner when making an appropriate restriction between species:

- (A) Identify generic claims or indicate that no generic claims are present, and
- (B) Clearly identify each of the disclosed species, to which claims are to be restricted. "The species are preferably identified as the species of figures 1, 2, and 3"...If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted. [Emphasis added]

Therefore, it is not improper to identify a species requirement with respect to figures, rather than claims, as argued by Applicants. The Examiner may, for Applicant's convenience, include a proposed listing of claims to which he or she believes reads on particular species.

However as per MPEP 809.02(a), "to be complete, a reply to a requirement...should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added." Therefore, it is not a requirement for the Examiner to provide a listing of claims. It is a requirement for Applicants.

After a careful review of the specification, the following disclosed species are found:

Species A is directed towards the transportation of tower sections (Figures 3-18 and 33-46), Species B is directed towards the transporting of blades (Figures 19-25), Species C is directed towards the transportation of nacelles (Figures 26-32), and Species D is directed towards the transportation of rotor hubs (Figures 47 and 48).

However, the application does not include claims directed towards all of the identified species above. To the contrary, only Species A and B are claimed.

As per MPEP 808.02, restriction is proper if the inventions as claimed are shown to be independent or distinct under the criteria of MPEP 806.05(c). [Emphasis added]

It is agreed only two of the species identified above should have been restricted. Therefore, the restriction requirement dated September 16, 2004 should have been made as follows:

Species A – Directed towards Figures 3-18 and 33-46; and,
Species B – Directed towards Figures 19-25.

Claim 11 is still identified as being generic. Upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

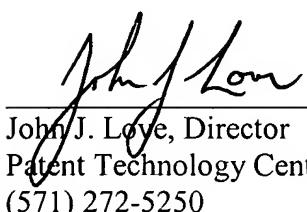
The petition is **GRANTED** to the extent indicated.

It is acknowledged that Applicants' requested relief included an election of Species A, as well as identifying claims 1-7 and 9-31 that read on the elected Species.

Since Applicants have received an examination of the above-noted claims consistent with the election of Species A, it will not be necessary for the examiner to modify the restriction requirement in another non-final Office action.

It is also noted that a Request for Continued Examination was filed on May 2, 2006. Therefore, the application will be returned to the examiner for immediate action consistent with this decision.

Telephone inquiries should be directed to D. Glenn Dayoan, Supervisory Patent Examiner, at (571) 272-6659.


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Dgd/snm: 6/13/06

